

Appl. No. 09/844,175
Response to Office Action mailed 9/28/2005

REMARKS

Applicants wish to thank the Examiner for the courtesies extended to the undersigned during the telephone interview. An interview summary accompanies this response.

Applicants hereby add new claims 89-91 and cancel claim 55. Accordingly, claims 31-42, 54, 56-65, 67-70, and 75-91 are pending in the present application.

Claims 54-61, 64-65, 69-70, 76, 79-80, 83-84, and 87-88 are objected to. Claims 54-61, 64-65, 69-70, 76, 79-80, 83-84, and 87-88 are rejected under the judicially created doctrine of obviousness-type double patenting. Claims 54, 61, 64, 69-70, 76, 79-80, 83-84 and 87-88 stand rejected under 35 USC 102(e) for anticipation by U.S. Patent No. 5,201,992 to Marcus et al.

Applicants respectfully traverse the rejections and urge allowance of the present application.

Referring to the objection to the drawings, Applicants respectfully submit the objection is improper in view of the usage of the transitional phrase "comprising" as opposed to "consisting of" in the pending claims. Accordingly, the pending claims are open ended as opposed to the closed scope afforded to claims which use "consisting of" which are not present in the application. Applicants refer to MPEP 2111.03 (8th ed. rev. 3) which discusses usage of the transitional phrases "comprising" and "consisting of." More specifically, such MPEP section states that "comprising" is synonymous with "including," "containing" or "characterized by", and is inclusive or open-ended and does not exclude

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additional, unrecited elements or method steps. It follows that the claims which recite "an apex" also cover or read on constructions including a plurality of apexes by use of the term "comprising." Inasmuch as the drawings of the present application show every feature of the claims and the claims are open ended, Applicants respectfully submit the pending drawings are proper and Applicants respectfully request withdrawal to the objection to the drawings.

Similarly, referring to the objection to the pending claims which recite "an apex," the claims utilize the transitional phrase "comprising" and accordingly are open-ended as set forth in the MPEP and cover constructions including one apex or a plurality of apexes. In view of the MPEP authority and discussions with the Examiner, Applicants respectfully submit the limitations of the claims are properly shown in the drawings and Applicants respectfully request withdrawal of the objection to the drawings.

The position of Applicants with respect to the objections to the drawings and the claims was favorably received by the Examiner during the telephone interview. Accordingly, it is Applicants understanding that the objections to the drawings and the claims will be withdrawn and Applicants need not submit new drawings at this time. Applicants respectfully request a telephone call if further clarification or discussion is desired. Applicants respectfully request identification of authority in support of any objection to the drawings or claims if the objections are not withdrawn so Applicants may appropriately respond.

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Referring to the obviousness type double patenting rejection, Applicants submit a Terminal Disclaimer with respect to US Patent No. 5,523,697 herewith. Applicants respectfully request withdrawal of the rejection in view of the filed Terminal Disclaimer.

Referring to the statement of reasons for the indication of allowable subject matter, Applicants note that the dependent claims 81-88 further define the independent claims from which they depend and operate to recite specific examples of the knife-edge lines recited in the independent claims. As set forth in Applicants' response of June 17, 2004, knife-edge lines are understood by one of skill in the art especially when properly considered in view of the explicit teachings of the drawings and the specification of the originally filed application and the independent claims are not limited to polyhedrons nor triangular prism constructions.

Referring to the rejection of claim 54 over Marcus, the probe comprises an apex in the form of a knife-edge line and the knife-edge line is formed on a projection from a substrate as recited in previously pending claim 55. Claim 55 was not rejected over the prior art and Applicants respectfully request withdrawal of the rejection of claim 54 over Marcus in view of such claim now reciting limitations of previously pending claim 55.

The claims which depend from independent claim 54 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Applicants have made amendments to some of the claims which depend from claim 54 as indicated above for consistency.

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Applicants have made amendments to claim 77 for clarification.

Referring to claim 79, the Office alleges that Marcus anticipates the claimed electrical system. However, the teachings identified by the Office on page 5 of the Action fail to disclose or suggest the claimed conductive pad or the removable engagement probe comprising an apex in the form of a knife-edge line and comprising semiconductor material and sized and positioned to engage the single conductive pad. Marcus pertains to structures for *field emission devices* as set forth at least in the Abstract of Marcus and fails to disclose or suggest the claimed pad or the apex sized and positioned to engage the single conductive pad. Applicants have electronically searched Marcus and have failed to uncover any teachings directed to a single conductive pad or engagement thereof. Positively-recited limitations of claim 79 are not disclosed nor suggested by the prior art and claim 79 is allowable for at least this reason.

The claims which depend from independent claim 79 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Applicants have identified herein claimed limitations of claim 79 which are not disclosed nor suggested by the teachings of the prior art identified by the Office. In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R §1.104(c)(2). In particular, 37 C.F.R §1.104(c)(2) provides that *the pertinence of*

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each reference, if not apparent, must be clearly explained and each rejected claim specified. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable. Applicants respectfully request clarification of the rejections with respect to specific references and specific reference teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if claim 79 is not found to be allowable.

Applicants hereby add new claims 89-91 which respectively include limitations of previously pending dependent claims 56, 57, and 60. New claims 89-91 are believed to be in condition for allowance inasmuch as claims 56, 57 and 60 were not rejected over the prior art.


Applicants include a supplemental IDS herewith.

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The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Dated: 1/27/06

By: 
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